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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,743	02/19/2004	Hideyuki Yanami	KAS-199	1792
24956 7590 08/28/2008 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
EXAMINER				
WRIGHT, PATRICIA KATHRYN				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
08/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/780,743

**Applicant(s)**

YANAMI ET AL.

**Examiner**

P. Kathryn Wright

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9, 10, 13-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-10, 13-16 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 08, 2008 has been entered.

### ***Status of the Claims***

2. This action is in response to papers filed May 08, 2008 in which claims 9, 15-16 and 19 were amended and claims 11-12 and 17-18 were canceled. The amendments have been thoroughly reviewed and entered.

Any objection/ rejection not repeated herein have been withdrawn by the Examiner.

Claims 9-10, 13-16 and 19 are under prosecution.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-10, 13-16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 15 now recite a sample in a sample container being discharged into a reaction cuvette by using the plurality of sample probes. Claims 9 and 15 omit essential structural cooperative relationships between the elements of claim. That is, where is the location of the sample container and reaction cuvette in relation to the other elements? It is assumed by the Office that the sample container is at the sample sucking position and reaction cuvette is at the sample discharge position. However, clarification is requested.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-10, 13-16 and 19 are again rejected under 35 U.S.C. 102(b) as being anticipated by Itoh (US Patent no. 5,445,037).

Itoh teaches the sample dispensing apparatus and method of operating the same as recited in claims 9 and 15. The Itoh apparatus includes a plurality of probes, each probe includes a probe head 32 and 38 with nozzles 33, 39 for aspirating and discharging the sample. The plurality of nozzles being movable to aspirate and

discharge the sample independently of each other. The apparatus of Itoh includes rails 31 and 37 that the sample probe heads 32, 38 are mounted on, respectively (see col. 3, lines 5-67 and Fig. 1). As shown Fig. 1, the rails 31 and 37 are attached together at either end by transverse support members (no reference nos.), thereby forming a closed "loop". The analyzer system of Itoh also includes a controller 100 for controlling the probes independently so that they can reciprocally move between a sample suction position 62 and a sample discharge position 64 (see col. 6, line 62+). The controller can operate the probe heads 32, 38 sequentially or simultaneously (see col. 7, line 55 et seq). The sample probes 32 and 38 are at horizontally deviated position so that they can avoid colliding with each other (see col. 3, lines 62-65). The sample probes 32 and 38 alternately access a sample container (e.g., 11T) at the sample sucking position 62 and dispense into a reaction vessel (e.g., 21T) at discharge position 64 (see col. 7, line 24- col. 10, line 5).

Regarding claims 10 and 16, the rails 31 and 37 are attached together at either end by transverse support members, thereby forming a closed "loop" in a rectangular shape as seen from above, see Fig. 1.

With respect to claims 13 and 19, the controller can operate the probes independently (simultaneously or sequentially), see col. 7, line 55 et seq. Thus, it is expected that one of the probes can be stopped while the other probe continues to operate.

***Response to Arguments***

7. Applicant's arguments filed May 08, 2008 have been fully considered but they are not persuasive.

Regarding the previous rejection of claims 9, 10, 13-16 and 19 under 35 U.S.C. 102(b) as being anticipated by Itoh (US Patent no. 5,445,037), Applicant argues the suction unit 33 is arranged on one rail and the suction unit 39 is arranged on the other rail. The suction unit 33 discharges the parent sample into one child sample container, and the suction unit 39 discharges parent sample into another child sample. From this, Applicant concludes Itoh does not disclose the rails being arranged in a closed loop, as required by claims 9 and 15.

The Examiner respectfully disagrees with Applicant's assertions. First it is noted that the claims do require that both sample probes dispense into same reaction cuvette. The claims merely recite a sample in a sample container being discharged into a reaction cuvette by using the plurality of sample probes. The language of the claim can be reasonably interpreted so that sample in one sample container is discharged into the same or different reaction cuvette using each of the plurality of probes. Clearly, the Itoh reference teaches a sample in a sample container (e.g., 11T) is discharged into different reaction cuvettes (e.g., 21T, 22T, 23T) using each of the plurality of sample probes 32, 38. Secondly, the sample probe rails 31 and 37 are attached together at either end by transverse support members (no reference number; see Fig. 1), thereby forming a closed "loop" in a rectangular shape, as seen from above.

Thus, for the reason delineated above, the claims remain rejected under 35 U.S.C. 102(b) as being anticipated by Itoh (US Patent no. 5,445,037).

***Conclusion***

8. No claims allowed.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/  
Patent Examiner, Art Unit 1797